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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
1654	27

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/486,239	Applicant(s) Fyfe, L.
	Examiner Patricia Patten	Art Unit 1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 26, 2003* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *10, 11, and 14-19* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *10, 11, and 14-19* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 10-11 and 14-19 are pending in the application and were examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 14, 16 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Purohit et al. (US 4,966,754) for the reasons set forth in the previous Office Action.

Applicants' arguments were fully considered but not found convincing.

Applicant contends that Purohit et al. actually taught away from the claimed invention. This argument is not persuasive for the following reasons: Applicant contends that "Purohit et al. Proceeds to describe that such [microbial] agents tend to be, to some extent, toxic and may be dermatological unacceptable" (p. 3-Arguments - wherein 'such' are agents such as propyl paraben and Dowicil 200). Further "Purohit et al. Explicitly teaches against the use of benzoic acid, methyl paraben, etc" (p. 4-Arguments). However, it appears that Applicants have taken this teaching out of context. Below is the excerpt from the '745 patent:

"Thus, cosmetics have been formulated with a variety of bactericides which are effective against microorganisms such as Staphylococcus aureus. Such bactericides or antimicrobial compounds are generally synthetic or compounds such as methyl or propyl paraben, Dowicil 200, or various quaternary compounds. Care must be taken that the antimicrobial agents are non toxic and do not irritate the skin to which the cosmetic is applied" (col.1, lines 15-26).

Here, Purohit et al. are simply stating a general concept in the art of cosmetology, that ingredients intended for use on the skin are preferably non-toxic and non-irritating. Purohit et al. did not specifically state that agents such as propyl paraben or methyl paraben were toxic or irritating to the skin and therefore did not explicitly teach away from the Instantly claimed invention.

Applicant further argues that Purohit et al. did not expressly teach that the claimed invention would be effective as an anti-microbial agent, according to the preferred embodiments of Purohit et al. (p.3-Arguments). Although Purohit et al. did not explicitly teach the claimed invention, the motivation for the combination of the ingredients flowed naturally from Purohit et al. in that each individual ingredient was already known in the art for inhibiting microorganisms in cosmetics. As stated in the previous Office Action, motivation for combining the ingredients is manifested from the knowledge that the ingredients are each known from the same purpose: "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose" (MPEP . Thus, the combination of the constituents would have been well within the purview of the ordinary artisan with Purohit et al. before him.

Applicant argues that "..even assuming arguendo, that one of ordinary skill in the art could be motivated to Purohit et al. To attempt to combine an essential oil with a conventional preservative, Purohit et al. Neither teaches nor suggests that such combinations could be synergistic" (p. 4-Arguments). It is noted however, that Applicant's claims are drawn to a much broader class of combinations than any synergistic combination found in the Instant specification and therefore remain obvious in light of Purohit et al.

Claims 10-11 and 14-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Purohit et al. (US 4,966,754) in view of Zimmerman et al. (US 5,443,817) for the reasons set forth in the previous Office Action.

Applicant argues that "Zimmerman et al. Fails to teach or suggest which is lacking in Purohit et al., namely, a suggestion to combine essential oils, which are taught to be safe and effective as microbial agents, with agents such as benzoic acid, methyl paraben, ethyl paraben, or butyl paraben, which it teaches to be less dermatological acceptable, and do so in concentrations that are 20-fold to 2-fold less than that which Purohit et al. Teaches is necessary for effective anti-microbial action" (p. 7- Arguments). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As discussed *supra,* Applicant has failed to persuade the Examiner that Purohit et al. taught that butyl paraben was 'less dermatological acceptable' because no specific teaching against these materials can be found in Purohit et al.. Zimmerman et al. specifically taught that microbial agents were advantageously employed in cosmetic compositions at the claimed ranges. Thus, the ordinary artisan would have had a reasonable expectation that the incorporation of

known anti-microbial agents, such as the agents Instantly claimed, in the amounts disclosed by Zimmerman et al. would have acted beneficially with regard to inhibiting the growth of microbes in cosmetics.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

No Claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback is on 703-306-3220 The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CHRISTOPHER R. TATE
PRIMARY EXAMINER